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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/930,169 | 08/16/2001 | Sunghoon Kim | 058333-0106 | 1098 |

22428 7590 08/27/2003

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

BORIN, MICHAEL L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1631

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DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/930,169

Applicant(s)
Kim et al

Examiner
Michael Borin

Art Unit
1631



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 9, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, and 5 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1, 4, and 5 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Part III DETAILED ACTION

Claims 2,3 are canceled. Claims 4, 5 are added.

The response filed 06/09/2003 is not responsive as the applicant did not make any election between Groups identified in the restriction requirement of 5/7/2003. Combining all three peptides into one claim does not eliminate lack of common core structure between the peptides. Examiner agrees, however to combine examination of SEQ ID Nos. 1 and 2, as both of them have a common fragment of residues 1-108. As for SEQ ID No. 3, Examiner maintains that it does not have an identified common core structure and requires a separate search.

In addition, applicant submitted new claims 4,5, which are subject to additional restriction requirement. Taken together amendment to the product claim and addition of method claims, the following restriction requirement is deemed to be necessary:

Restriction Requirement

Restriction to one of the following inventions is required under 35 U.S.C. 121:

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- I. Claim 1, in part, drawn to peptide SEQ ID Nos. 1,2 classified in class 530, subclass 350.
- II. Claim 1, in part, drawn to peptide SEQ ID Nos. 3, classified in class 530, subclass 350.
- III. Claim 4, in part, drawn to method for inducing IL-8 production using peptide SEQ ID Nos. 1,2, classified in class 514, subclass 12.
- IV. Claim 4, in part, drawn to method for inducing IL-8 production using peptide SEQ ID Nos. 1,2, classified in class 514, subclass 12.
- VI. Claim 5, in part, drawn to method for inducing TNF production using peptide SEQ ID Nos. 1,2, classified in class 514, subclass 12.
- VII. Claim 5, in part, drawn to method for inducing TNF production using peptide SEQ ID Nos. 1,2, classified in class 514, subclass 12.

The inventions are distinct, each from the other because of the following reasons:

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Inventions of Groups I-II are drawn to independent and/or patentably distinct compounds since each of these compounds possess different structure (e.g., primary, secondary and tertiary structure) and/or physico-chemical properties, and/or capable of separate manufacture and/or use. These compounds do not share an identified common structure which elicits a common activity. The correspondent methods of use III and IV, and V and VI, are independent and/or distinct due to the use of different patentably distinct agents.

Inventions III, V and IV, VI are patentably distinct methods of use as they have different effects.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (703) 305-4506. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Mr. Michael Woodward, can be reached at (703) 308-4028. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

August 25, 2003

MICHAEL BORIN, PH.D
PRIMARY EXAMINER

mlb

